

**REMARKS**

**General Remarks**

Claims 1-16 are all the claims currently pending in the present application.

The Examiner has acknowledged Applicant's claim for foreign priority and the receipt of the certified copy of the priority document. The Examiner has also reviewed and considered the references cited in the Information Disclosure Statements filed April 9, 2003 and August 1, 2001.

Applicant respectfully requests that the Examiner review and consider the references cited in the Information Disclosure Statement filed January 13, 2005.

**Claim Objections**

Claims 1, 3, 9, and 11 stand objected to due to informalities. (Office Action, p. 2). With this Amendment, Applicant amends Claims 1, 3, 9, and 11, as suggested by the Examiner. Applicants therefore respectfully request that the objections to Claims 1, 3, 9, and 11 be reconsidered and withdrawn.

**Claim Rejections - 35 U.S.C. § 112**

Claims 4 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that the term "immediately," as recited in claims 4 and 12 is not defined by the claim, that the specification does not provide a standard

for ascertaining the requisite degree, and that one of skill in the art would not be reasonably apprised of the scope of the invention. (Office Action, p. 5).

Applicant submits, contrary to the assertion of the Examiner, that support for the term “immediately” is clearly found in the specification at least at page 9, ln. 11, page 10, ln. 16, page 20, lns. 19-29, and page 22, ln. 16. Specifically, Applicant submits that the term “immediately,” as recited in the claims refers to the fact that voice data and/or low speed data, demodulated in a separate processing block (see processing block 4 of Fig. 1), are demodulated directly without first saving any information to memory. (See page 20, lns. 19-29).

Therefore, in view of the above, Applicant respectfully requests that the rejection of Claims 4 and 12 under 35 U.S.C. § 112 be reconsidered and withdrawn. Applicant further submits that Claims 4 and 12 are patentable at least by virtue of their dependence on Claims 1 and 9, respectively, as discussed below.

**Claim Rejections**

Claims 1-3, 5-11 and 13-16 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Iwakiri, U.S. Patent No. 6,795,488 (“Iwakiri”). Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Iwakiri.

Claims 1 and 9. Regarding claims 1 and 9, Iwakiri fails to disclose or suggest allocating data to reception blocks depending on service type, as claimed. The Examiner asserts that the claimed reception blocks are disclosed by the finger units (e.g. finger units 290A, 290B, and

290C of Fig. 2), which are “capable of receiving a signal from a different type of communications medium.”

First, Applicant notes that contrary to the assertion of the Examiner, there is no disclosure in Iwakiri that data is allocated to finger units 290A, 290B, and 290C depending on service types. As described, the signal allocating unit 260 determines which signals are allocated to the finger units 290. (See Figs. 2 and 5 and col. 32, ln. 12-col. 33, ln. 56). According to Iwakiri, the signal allocating unit 260, illustrated in Fig. 5, receives a delayed receiving signal and first, second, and third interference replica signals. The interference signal removing unit 261 then subtracts the respective first, second, and third interference signals from the delayed receiving signal, thereby creating first, second, and third interference removed receiving signals, respectively. The first, second, and third interference removed receiving signals are then output to the first, second, and third finger units through the first, second, and third selectors, respectively. Therefore, according to this description, the signals received by the first, second, and third finger units are not allocated depending on service types, as claimed.

Further, regarding the Examiner’s assertion that the first, second, and third finger units are “capable of receiving a signal from a different type of communications medium,” it appears that the Examiner is asserting that it is inherent from the description of Iwakiri that the first, second, and third finger units receive signals according to service types. However, contrary to the assertion of the Examiner, even assuming, *arguendo*, that the Examiner is correct and that the first, second, and third finger units were capable of receiving signals from different types of

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communication mediums, there is no evidence that it would be inherent that data would be allocated to the first, second, and third finger units depending on service types, as claimed.

Applicant acknowledges that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention.<sup>1</sup> However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”<sup>2</sup> “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.”<sup>3</sup> Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure.<sup>4</sup>

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<sup>1</sup> See *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981).

<sup>2</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

<sup>3</sup> *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (*emphasis in original*); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

<sup>4</sup> See *Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

Thus, even if it were *assumed* in this case that the first, second, and third finger units were capable of receiving signals from different types of communication mediums, as asserted by the Examiner, such a disclosure is insufficient to meet the high burden of anticipation, because there is no evidence that reception blocks to which data is allocated depending on service types is “necessarily present” in Iwakiri.

Claims 2-8 and 10-16. Applicant submits that Claims 2-8 and 10-16 are patentable at least by virtue of their dependence on Claims 1 and 9.

Regarding Claim 3, Applicant also submits that Iwakiri fails to disclose or suggest a plurality of reception processing blocks, each of which contains searcher means, as claimed. With respect to this limitation, the Examiner refers to the searching means describes at col. 4, ln. 42 of Iwakiri. Regarding this searching means, Applicant notes that this searching means refers to the searcher unit 210 as illustrated in Fig. 2. Further, Applicant notes that this searching means is not contained within any reception processing block, as explained by the Examiner (see above, the Examiner refers to finger units 290A, 290B, and 290C as reception processing blocks, as claimed). Further, there is only a single searching unit described in Iwakiri and Iwakiri fails to disclose or suggest a plurality of reception blocks, each containing a searcher means, as claimed.

Regarding Claims 6 and 14, Applicant also submits that Iwakiri fails to disclose or suggest a plurality of memories, “each of which is connected between said decoding means and RAKE combining means in each of said reception processing blocks.” In other words, Iwakiri fails to disclose or suggest a plurality of reception processing blocks, each of which includes a

memory connected between a decoding means and a RAKE combining means. As discussed above with respect to Claims 1 and 9, Iwakiri fails to disclose a plurality of reception processing blocks, as claimed. Further, even assuming, *arguendo*, that the finger units 290A, 290B, and 290C of Iwakiri are equivalent to the plurality of processing blocks, as asserted by the Examiner, the finger units 290A, 290B, and 290C fail to include a memory connected between a decoding means and a RAKE combining means.

Regarding Claims 7, 8, 15, and 16, Applicant also submits that Iwakiri fails to disclose or suggest demodulating packet data or high speed data when a data field of a finger unit of a reception processing block is vacant, as recited in Claims 7 and 15, or allocating voice data or low speed data from another user to a reception processing block having a vacant finger unit, as recited in Claims 8 and 16. Regarding these limitations, the Examiner asserts that “Iwakiri further teach the claimed subject matter by the inherency of the operation of the allocating unit.” (Office Action, p. 4). Applicant submits that the operation of the signal allocating unit 260 of Iwakiri (described above with respect to Claims 1 and 9), fails to render the above-described limitations inherent.

Applicant again notes that evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”<sup>5</sup> The description of the operation of

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<sup>5</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

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the signal allocating unit 260 of Iwakiri neither describes the claimed limitations, nor suggests the claimed limitations, nor renders the claimed limitations inherent. Applicant therefore respectfully asserts that the limitations of Claims 7, 8, 15, and 16 are not inherent in the disclosure of Iwakiri and respectfully request that the Examiner clearly explain how these limitations could be inherent in the cited reference.

Claims 1-16 are patentable over Iwakiri. In view of at least the above, Applicant submits that Iwakiri fails to anticipate, teach, or suggest Claims 1-16 and respectfully requests that the Examiner's rejections of Claims 1-16 be reconsidered and withdrawn.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

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Respectfully submitted,

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